

ESTTA Tracking number: **ESTTA402469**

Filing date: **04/07/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91197636
Party	Defendant Breton S.P.A.
Correspondence Address	Donna J. Bunton Nixon & Vanderhye P.C. 11th Floor 901 North Glebe Road Arlington, VA 22203  nixonptomail@nixonvan.com, djb@nixonvan.com
Submission	Answer
Filer's Name	Donna J. Bunton [VA Bar Member]
Filer's e-mail	nixonptomail@nixonvan.com
Signature	/Donna J. Bunton/
Date	04/07/2011
Attachments	622-58.pdf ( 16 pages )(3236444 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

CEMSTONE PRODUCTS COMPANY	)	Attorney Ref.: DJB/622-58
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91197636
	)	
BRETON S.P.A.	)	
	)	
Applicant.	)	

**ANSWER**

Applicant, Breton S.P.A., hereby answers the allegations of the Notice of Opposition as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1 of the Notice of Opposition and therefore denies same.
2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 2 of the Notice of Opposition and therefore denies same.
3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 3 of the Notice of Opposition and therefore denies same.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 4 of the Notice of Opposition and therefore denies same.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 5 of the Notice of Opposition and therefore denies same.

6. Applicant admits the allegations of Paragraph 6 and specifically states that no consent, license or approval by Applicant is necessary with regard to Applicant's use and registration of the mark BRETONCEMSTONE.

7. Applicant denies the allegations of Paragraph 7 of the Notice of Opposition.

8. Applicant denies the allegations of Paragraph 8 of the Notice of Opposition.

#### **AFFIRMATIVE DEFENSES**

9. The differences between the marks BRETONCEMSTONE and CEMSTONE combined with the differences between the respective goods and services clearly are sufficient to preclude any likelihood of confusion, mistake or deception.

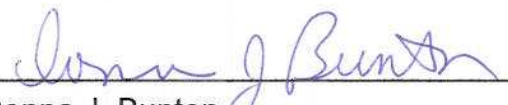
10. The dominant portion of the mark BRETONCEMSTONE clearly is BRETON. BRETON is Applicant's well known company name and house mark which customers and potential customers for Applicant's goods would immediately recognize, further precluding any likelihood of confusion, mistake or deception. In this regard, Applicant is the owner of valid and subsisting registrations of the marks BRETON (Reg. No. 3196912), BRETONSTONE (Reg. No. 3209296) and BRETONTERASTONE (Reg. No. 3261216), copies of which are annexed hereto.

11. The channels of trade and types of purchasers for Opposer's goods on which its mark is alleged to be used are different from the channels of trade and types of purchasers for the goods on which Applicant's mark is used or intended to be used.

12. The purchasers for Applicant's goods are sophisticated purchasers, further precluding any likelihood of confusion, mistake or deception.

WHEREFORE, Applicant prays that the Notice of Opposition be dismissed and that it be adjudged entitled to the registration of its mark in the subject Application Serial No. 76/549,602.

Respectfully submitted,  
BRETON S.P.A.

By:   
Donna J. Bunton  
NIXON & VANDERHYE P.C.  
901 North Glebe Road, 11<sup>th</sup> Floor  
Arlington, VA 22203  
703-816-4003

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Answer was served upon the following attorney of record for Opposer by depositing same in the United States mail, first class, postage prepaid, this 7<sup>th</sup> day of April, 2011:

Donald W. Niles, Esq.  
**Niles Law office, P.A.**  
121 Colfax Aven. SW  
Wadena, MN 56482

Donna J. Buntz



Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2011-04-01 11:52:23 ET

Serial Number: 79005353 Assignment Information Trademark Document Retrieval

Registration Number: 3196912

Mark

# BRETON

(words only): BRETON

Standard Character claim: Yes

**Current Status:** Registered. The registration date is used to determine when post-registration maintenance documents are due.

**Date of Status:** 2007-01-09

**Filing Date:** 2004-04-30

**Transformed into a National Application:** No

**Registration Date:** 2007-01-09

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 117

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

**Current Location:** 650 -Publication And Issue Section

**Date In Location:** 2007-01-09

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## LAST APPLICANT(S)/OWNER(S) OF RECORD

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1. BRETON SPA

**Address:**

BRETON SPA

Via Garibaldi 27 I-31030 Castello di Godego (Treviso)

Italy

**Legal Entity Type:** Joint Stock Company

**State or Country Where Organized:** Italy

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### GOODS AND/OR SERVICES

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**International Class:** 007

**Class Status:** Active

EQUIPMENT, MACHINES AND NUMERICAL CONTROL MACHINE TOOLS FOR FORMING, SIZING, POLISHING AND SHAPING OF NATURAL STONES, ARTIFICIAL STONES, AGGLOMERATED STONES, CERAMIC AND METALLIC MATERIALS, GLASS; TRANSPORT SYSTEMS COMPRISED OF CONVEYORS AND HANDLING EQUIPMENT FOR MOVING AND CARRYING NATURAL STONES, ARTIFICIAL STONES, AGGLOMERATED STONES, CERAMIC AND METALLIC MATERIALS, GLASS AND REPLACEMENT PARTS FOR THE AFORESAID GOODS

**Basis:** 66(a)

**First Use Date:** (DATE NOT AVAILABLE)

**First Use in Commerce Date:** (DATE NOT AVAILABLE)

**International Class:** 019

**Class Status:** Active

NATURAL AND ARTIFICIAL AGGLOMERATED STONES AND CERAMIC MATERIALS, NAMELY BLOCKS, SLABS, TILES AND OTHER SET MOLDED FORMS OF STONE AND CERAMIC FOR USE IN INDOOR AND OUTDOOR FLOORING, INDOOR AND OUTDOOR WALL CLADDING AND FOR BUILDING AND CONSTRUCTION; NATURAL AND ARTIFICIAL STONE COMPOSITES COVERED WITH REINFORCING ELEMENTS OF WOOD FIBER AND PLASTIC WEBBING FOR BUILDING

**Basis:** 66(a)

**First Use Date:** (DATE NOT AVAILABLE)

**First Use in Commerce Date:** (DATE NOT AVAILABLE)

**International Class:** 037

**Class Status:** Active

Installation, maintenance and repair of machines, equipment and numerical control machine tools

**Basis:** 66(a)

**First Use Date:** (DATE NOT AVAILABLE)

**First Use in Commerce Date:** (DATE NOT AVAILABLE)

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### ADDITIONAL INFORMATION

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**Prior Registration Number(s):**

1356244

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### MADRID PROTOCOL INFORMATION

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**International Registration Number:** 0833398

**International Registration Date:** 2004-04-30

**Priority Claimed:** Yes

**Date of Section 67 Priority Claim:** 2004-02-10

**International Registration Status:** Request For Extension Of Protection Processed

**Date of International Registration Status:** 2004-10-21

**International Registration Renewal Date:** 2014-04-30

**Notification of Designation Date:** 2004-10-21

**Date of Automatic Protection:** 2006-04-21

**Date International Registration Cancelled:** (DATE NOT AVAILABLE)

**First Refusal:** Yes

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### PROSECUTION HISTORY

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**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2008-05-02 - Final Decision Transaction Processed By IB

2007-08-15 - Final Disposition Notice Sent To IB

2007-08-15 - Final Disposition Processed

2007-08-09 - Final Disposition Notice Created, To Be Sent To IB

2007-01-09 - Registered - Principal Register

2006-10-24 - Published for opposition

2006-10-04 - Notice of publication

2006-09-12 - Law Office Publication Review Completed

2006-09-07 - Assigned To LIE

2006-08-20 - Approved for Pub - Principal Register (Initial exam)

2006-07-26 - Amendment From Applicant Entered

2006-07-19 - Communication received from applicant

2006-07-19 - PAPER RECEIVED

2006-04-13 - Notification Of Possible Opposition - Processed By IB

2006-04-10 - LETTER OF SUSPENSION E-MAILED

2006-04-10 - Suspension Letter Written

2006-03-23 - Notification Of Possible Opposition Sent To IB

2006-03-23 - Notification Of Possible Opposition Created, To Be Sent To IB



2006-02-09 - New Representative At IB Received  
2006-02-09 - Amendment From Applicant Entered  
2005-08-29 - Communication received from applicant  
2006-02-03 - Petition Granted - Remail Office Action  
2005-08-29 - Petition To Revive-Received  
2005-08-29 - PAPER RECEIVED  
2005-06-29 - Abandonment Notice Mailed - Failure To Respond  
2005-06-29 - Abandonment - Failure To Respond Or Late Response  
2005-01-13 - Refusal Processed By IB  
2004-11-30 - Non-final action mailed  
2004-11-28 - Non-Final Action Written  
2004-11-27 - Assigned To Examiner  
2004-10-22 - New Application Entered In Tram  
2004-10-21 - Sn Assigned For Sect 66a Appl From IB

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**ATTORNEY/CORRESPONDENT INFORMATION**

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**Attorney of Record**

DONNA J BUNTON

**Correspondent**

DONNA J BUNTON

NIXON &amp; VANDERHYE PC

901 NORTH GLEBE ROAD 11TH FLOOR

ARLINGTON VA 22203

Phone Number: 703 816 4003

Fax Number: 703 816 4100

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This page was generated by the TARR system on 2011-04-01 11:53:00 ET

Serial Number: 79004000 Assignment Information Trademark Document Retrieval

Registration Number: 3209296

Mark

# BRETONSTONE

(words only): BRETONSTONE

Standard Character claim: Yes

Current Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Date of Status: 2007-02-13

Filing Date: 2004-03-18

Transformed into a National Application: No

Registration Date: 2007-02-13

Register: Principal

Law Office Assigned: LAW OFFICE 104

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

Current Location: 650 -Publication And Issue Section

Date In Location: 2007-02-13

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## LAST APPLICANT(S)/OWNER(S) OF RECORD

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1. BRETON SPA

**Address:**

BRETON SPA  
Via Garibaldi 27 I-31030 Castello di Godego (Treviso)  
Italy

**Legal Entity Type:** Joint Stock Company

**State or Country Where Organized:** Italy

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## GOODS AND/OR SERVICES

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**International Class: 007****Class Status:** Active

MACHINES FOR MANUFACTURING COMPOUND STONE AND CERAMIC MATERIALS FOR USE IN BUILDING CONSTRUCTION AND FURNITURE; MACHINES AND TRANSPORT, HANDLING AND STORING EQUIPMENT FOR PROCESSING NATURAL STONES, ARTIFICIAL STONES, COMPOUND STONES, CERAMIC AND GLASS MATERIALS, NAMELY, AUTOMATIC OR PROGRAMMABLE BLOCKSAW MACHINES, AUTOMATIC OR PROGRAMMABLE SLAB AND TILE SAW MACHINES, SLAB AND TILE CALIBRATING, GRINDING, POLISHING AND DRESSING MACHINES, CUTTING MACHINES, WAXING MACHINES, SQUARING AND CHAMFERING MACHINES, EDGE SHAVING AND POLISHING MACHINES, CONTOURING MACHINES, RESTORING, REINFORCING AND COATING MACHINES; AND REPLACEMENT PARTS FOR THE AFORESAID GOODS

**Basis:** 66(a)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)

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**International Class: 019****Class Status:** Active

NATURAL STONE, COMPOUND STONE AND CERAMIC MATERIAL, NAMELY, BLOCKS, SLABS, TILES AND OTHER SET MOLDED FORMS OF STONE AND CERAMIC FOR USE IN BUILDING CONSTRUCTION AND FURNITURE; NON-METALLIC COMPOSITE MATERIALS, NAMELY, NATURAL STONE, COMPOUND STONE AND CERAMIC MATERIALS, REINFORCED OR COATED WITH ELEMENTS COMPRISED OF FIBERS, MAT, WEB OR COMPOUNDED NATURAL LAYERS OF SAID MATERIALS FOR USE IN BUILDING AND CONSTRUCTION AND IN FURNITURE

**Basis:** 66(a)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)

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**ADDITIONAL INFORMATION****Prior Registration Number(s):**

1356244

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**MADRID PROTOCOL INFORMATION****International Registration Number:** 0829400**International Registration Date:** 2004-03-18**Priority Claimed:** Yes**Date of Section 67 Priority Claim:** 2004-02-10**International Registration Status:** Request For Extension Of Protection Processed**Date of International Registration Status:** 2004-08-13**International Registration Renewal Date:** 2014-03-18**Notification of Designation Date:** 2004-08-12**Date of Automatic Protection:** 2006-02-12**Date International Registration Cancelled:** (DATE NOT AVAILABLE)**First Refusal:** Yes

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**PROSECUTION HISTORY**

**NOTE:** To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-05-23 - Final Decision Transaction Processed By IB

2007-08-29 - Final Disposition Notice Sent To IB



2007-08-29 - Final Disposition Processed  
2007-08-24 - Final Disposition Notice Created, To Be Sent To IB  
2007-02-13 - Registered - Principal Register  
2006-11-28 - Published for opposition  
2006-11-08 - Notice of publication  
2006-10-10 - Law Office Publication Review Completed  
2006-10-06 - Assigned To LIE  
2006-09-29 - Approved for Pub - Principal Register (Initial exam)  
2006-09-12 - Amendment From Applicant Entered  
2006-08-11 - Communication received from applicant  
2006-08-11 - PAPER RECEIVED  
2006-07-28 - Letter of suspension mailed  
2006-07-27 - Suspension Letter Written  
2006-07-07 - Amendment From Applicant Entered  
2006-06-23 - Communication received from applicant  
2006-06-23 - PAPER RECEIVED  
2006-02-02 - Notification Of Possible Opposition - Processed By IB  
2006-01-12 - Notification Of Possible Opposition Sent To IB  
2006-01-12 - Notification Of Possible Opposition Created, To Be Sent To IB  
2006-01-09 - TEAS Change Of Correspondence Received  
2006-01-09 - Letter of suspension mailed  
2006-01-07 - Suspension Letter Written  
2005-12-05 - Amendment From Applicant Entered  
2005-11-28 - Communication received from applicant  
2005-11-28 - PAPER RECEIVED  
2005-05-26 - Final refusal mailed  
2005-05-25 - Final Refusal Written  
2005-04-27 - Amendment From Applicant Entered



2005-04-15 - Communication received from applicant

2005-04-15 - PAPER RECEIVED

2004-11-18 - Refusal Processed By IB

2004-10-15 - Non-final action mailed

2004-10-12 - Non-Final Action Written

2004-09-28 - Assigned To Examiner

2004-08-16 - New Application Entered In Tram

2004-08-13 - Sn Assigned For Sect 66a Appl From IB

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**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Attorney of Record**

DONNA BURTON

**Correspondent**

Donna J. Bunton

Nixon & Vanderhye P.C.

11th Floor

901 North Glebe Road

Arlington VA 22203

Phone Number: 703-816-4003

Fax Number: 703-816-4100

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Serial Number: 79003999 Assignment Information Trademark Document Retrieval

Registration Number: 3261216

Mark

# BRETONTERASTONE

(words only): BRETONTERASTONE

Standard Character claim: Yes

**Current Status:** Registered. The registration date is used to determine when post-registration maintenance documents are due.

**Date of Status:** 2007-07-10

**Filing Date:** 2004-03-18

**Transformed into a National Application:** No

**Registration Date:** 2007-07-10

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 104

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

**Current Location:** 650 -Publication And Issue Section

**Date In Location:** 2007-07-10

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## LAST APPLICANT(S)/OWNER(S) OF RECORD

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1. BRETON SPA

**Address:**

BRETON SPA  
Via Garibaldi 27 I-31030 Castello di Godego (Treviso)  
Italy

**Legal Entity Type:** Joint Stock Company

**State or Country Where Organized:** Italy

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## GOODS AND/OR SERVICES

---

**International Class: 007****Class Status:** Active

MACHINES FOR MANUFACTURING COMPOUND STONE AND CERAMIC MATERIALS FOR USE IN BUILDING CONSTRUCTION AND FURNITURE; MACHINES AND TRANSPORT, HANDLING AND STORING EQUIPMENT FOR PROCESSING NATURAL STONES, ARTIFICIAL STONES, COMPOUND STONES, CERAMIC AND GLASS MATERIALS, NAMELY, AUTOMATIC OR PROGRAMMABLE BLOCK SAW MACHINES, AUTOMATIC OR PROGRAMMABLE SLAB AND TILE SAW MACHINES, SLAB AND TILE CALIBRATING, GRINDING, POLISHING AND DRESSING MACHINES, CUTTING MACHINES, WAXING MACHINES, SQUARING AND CHAMFERING MACHINES, EDGE SHAVING AND POLISHING MACHINES, CONTOURING MACHINES, RESTORING, REINFORCING AND COATING MACHINES; AND REPLACEMENT PARTS FOR THE AFORESAID GOODS

**Basis:** 66(a)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)

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**International Class: 019****Class Status:** Active

NATURAL STONE, COMPOUND STONE AND CERAMIC MATERIAL, NAMELY, BLOCKS, SLABS, TILES AND OTHER SET MOLDED FORMS OF STONE AND CERAMIC FOR USE IN BUILDING CONSTRUCTION AND FURNITURE; NON-METALLIC COMPOSITE MATERIALS, NAMELY, NATURAL STONE, COMPOUND STONE AND CERAMIC MATERIALS, REINFORCED OR COATED WITH ELEMENTS COMPRISED OF FIBERS, MAT, WEB OR COMPOUNDED NATURAL LAYERS OF SAID MATERIALS FOR USE IN BUILDING CONSTRUCTION AND FURNITURE

**Basis:** 66(a)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)

---

**ADDITIONAL INFORMATION****Prior Registration Number(s):**

1356244

---

**MADRID PROTOCOL INFORMATION****International Registration Number:** 0829398**International Registration Date:** 2004-03-18**Priority Claimed:** Yes**Date of Section 67 Priority Claim:** 2004-02-10**International Registration Status:** Request For Extension Of Protection Processed**Date of International Registration Status:** 2004-08-13**International Registration Renewal Date:** 2014-03-18**Notification of Designation Date:** 2004-08-12**Date of Automatic Protection:** 2006-02-12**Date International Registration Cancelled:** (DATE NOT AVAILABLE)**First Refusal:** Yes

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**PROSECUTION HISTORY**

**NOTE:** To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-12-13 - Final Decision Transaction Processed By IB

2007-11-15 - Final Disposition Notice Sent To IB



2007-11-15 - Final Disposition Processed  
2007-11-07 - Final Disposition Notice Created, To Be Sent To IB  
2007-07-10 - Registered - Principal Register  
2007-04-24 - Published for opposition  
2007-04-04 - Notice of publication  
2007-03-02 - Law Office Publication Review Completed  
2007-03-01 - Approved for Pub - Principal Register (Initial exam)  
2007-01-29 - LIE Checked Susp - To Atty For Action  
2007-01-29 - Assigned To LIE  
2006-07-12 - Report Completed Suspension Check Case Still Suspended  
2006-02-02 - Notification Of Possible Opposition - Processed By IB  
2006-01-12 - Notification Of Possible Opposition Sent To IB  
2006-01-12 - Notification Of Possible Opposition Created, To Be Sent To IB  
2006-01-09 - TEAS Change Of Correspondence Received  
2006-01-09 - Letter of suspension mailed  
2006-01-07 - Suspension Letter Written  
2005-12-05 - Amendment From Applicant Entered  
2005-11-28 - Communication received from applicant  
2005-11-28 - PAPER RECEIVED  
2005-05-27 - Non-final action mailed  
2005-05-26 - Non-Final Action Written  
2005-05-02 - Amendment From Applicant Entered  
2005-04-15 - Communication received from applicant  
2005-04-15 - PAPER RECEIVED  
2004-11-18 - Refusal Processed By IB  
2004-10-15 - Non-final action mailed  
2004-10-12 - Non-Final Action Written  
2004-09-28 - Assigned To Examiner



2004-08-16 - New Application Entered In Tram

2004-08-13 - Sn Assigned For Sect 66a Appl From IB

---

**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Correspondent**

Donna J. Bunton

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901 North Glebe Road

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Fax Number: 703-816-4100

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